

1614

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT
(Under 37 CFR 1.97(b) or 1.97(c))

Docket No.
13095

DEC 2 2 2002
Re Application Of:

Robert H. Harris

DEC 23 2002

P#5

Serial No.

09/938,677

Filing Date

August 24, 2001

Examiner

Unassigned

Group Art Unit

1614

Title: NEW USES FOR AMINO ACID ANTICONVULSANTS

Address to:

Assistant Commissioner for Patents
Washington, D.C. 20231

37 CFR 1.97(b)

- The Information Disclosure Statement submitted herewith is being filed within three months of the filing of a national application other than a continued prosecution application under 37 CFR 1.53(d); within three months of the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; before the mailing of a first Office Action on the merits, or before the mailing of a first Office Action after the filing of a request for continued examination under 37 CFR 1.114.

37 CFR 1.97(c)

- The Information Disclosure Statement submitted herewith is being filed after the period specified in 37 CFR 1.97(b), provided that the Information Disclosure Statement is filed before the mailing date of a Final Action under 37 CFR 1.113, a Notice of Allowance under 37 CFR 1.311, or an Action that otherwise closes prosecution in the application, and is accompanied by one of:

- the statement specified in 37 CFR 1.97(e);

OR

- the fee set forth in 37 CFR 1.17(p).

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TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT
(Under 37 CFR 1.97(b) or 1.97(c))

Docket No.
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In Re Application: **Robert H. Harris**

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Group Art Unit

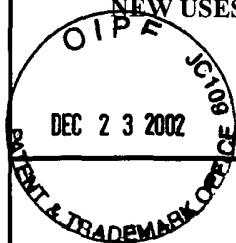
1614

NEW USES FOR AMINO ACID ANTICONVULSANTS

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Payment of Fee

(Only complete if Applicant elects to pay the fee set forth in 37 CFR 1.17(p))

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The Assistant Commissioner is hereby authorized to charge and credit Deposit Account No. 19-3886/RCT as described below. A duplicate copy of this sheet is enclosed.

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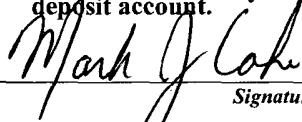
I certify that this document and fee is being deposited 12/18/02 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Michelle Mustafa

Typed or Printed Name of Person Mailing Certificate

*This certificate may only be used if paying by deposit account.


Signature

Mark J. Cohen

Registration No.: 32,211

Dated: December 18, 2002

Scully, Scott, Murphy & Presser
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CC:



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Robert H. Harris	Examiner:	Unassigned
Serial No.:	09/938,677	Art Unit:	1614
Filed:	August 24, 2001	Docket:	13095
For:	NEW USES FOR AMINO ACID ANTICONVULSANTS	Dated:	December 18, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

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INFORMATION DISCLOSURE STATEMENT

Sir:

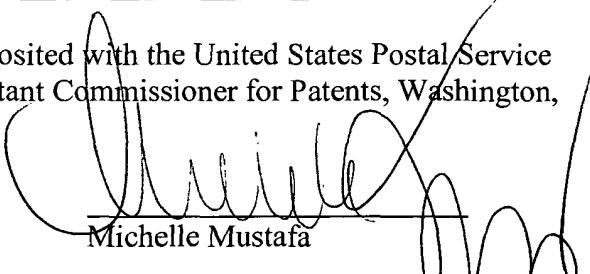
In accordance with 37 C.F.R. §§ 1.97 and 1.98, it is requested that the following references, which are also listed on the attached Form PTO-1449, be made of record in the above-identified case.

1. International Application WO 99/43309, published September 2, 1999
2. United States Patent Application No. 5,378,729; issued to Kohn, et al., dated January 3, 1995;

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on December 18, 2002.

Dated: December 18, 2002


Michelle Mustafa

3. Kohn H. et al., "Synthesis and anticonvulsant activities of α -heterocyclic α -acetamido-N-benzylacetamide derivatives", *Journal of Medicinal Chemistry*, United States 29 October 1993, vol. 36, no. 22, pp. 3350-3360, ISSN: 0022-2623, page 3355, column 1, paragraph 2, example 3F; table 1;
4. Shridhar V. Andurkar, et al., "The Anticonvulsant Activities of N-Benzyl 3-Methoxypropionamides", *Bioorganic & Medicinal Chemistry* 7 (1999), pp. 2381-2389, pg. 2381, column 2; example 3, pg. 2385, column 1, paragraph 2-paragraph 3, XP001097157;
5. Claudio Toniolo, et al., "A crystal-state, solution and theoretical study of the preferred conformation of linear C. α -diphenylglycine derivatives and dipeptides with potential anticonvulsant activity", *Int. J. Pept. Protein Res.* 44. 1994, 85-95, XP001074241, , Page 85, column 1, paragraph 2, Page 86, column 1; example XIV.
6. Andreas Billich, et al., "HIV proteinase inhibitors containing 2-aminobenzylstatine as a novel scissile bond replacement: biochemical and pharmacological characterization", *Antiviral Research* 25 (1994) pp. 215-233, XP008006766, page 216; table 1.
7. United States Patent No. 5,885,999, issued to Elliott, et al., dated March 23, 1999;
8. European Patent Application No. EP 0 997 147 A1, dated July 3, 1998;
9. United States Patent Application No.: 6,133,261, issued to Harris, dated October 17, 2000;
10. European Patent Application No.: EP 1 084 704 A1, dated March 21, 2001, Keiji Wada, et al.;
11. United States Patent Application No. US 6,228,875 B1, issued to Tsai, et al., dated May 8, 2001;
12. Solomon H. Snyder, et al., "D-Amino Acids as Putative Neurotransmitters: Focus on D-Serine, *Neurochemical Research*, Vol. 25, No. 5, 2000, pp. 553-560;
13. Myung Ha Yoon, MD, et al., "The effect of Intrathecal Gabapentin on Pain Behavior and Hemodynamics on the Formalin Test in the Rat, *International Anesthesia Research Society*, (1999), pp. 434-439;

14. David E. Baranano, et al., "Atypical neural messengers", *TRENDS in Neurosciences*, vol. 24, No. 2, February 2001, pp. 99-106;
15. J.M. Elliott, et al., "Serine Derived NK₁ Antagonists 1: The Effect of Modifications to the Serine Substituents", *Bioorganic & Medical Chemistry Letters* 8 (1998) pp.1845-1850;
16. Solomon H. Snyder, M.D., et al., "Novel Neurotransmitters and their Neuropsychiatric Relevance", *Am J Psychiatry*, 157:11, November 2000, pp. 1738-1751;
17. Robert Berkow, M.D., et al., "The Merck Manual of Diagnosis and Therapy", *Merck Research Laboratories*, (1992), pp. 1406-1615;
18. Harris FRC, and Schwarz Pharma AG, *Windover Information Inc.*, 2000, page 122;
19. International Application No. WO 99/03460, dated January 28, 1999;
20. Herman Wolosker, et al., "Serine racemase: A glial enzyme synthesizing D-serine to regulate glutamate-N-methyl-D-aspartate neurotransmission", *PNAS*, vol. 96, no. 23, November 9, 1999, pp. 13409-13414;
21. Fu Y, et al., "Systemic nicotine stimulates dopamine release in nucleus accumbens: Reevaluation of the role of N-methyl-D-aspartate receptors in the ventral tegmental area [In Process Citation]", *J Pharmacol Exp Ther* 2000, Aug;294(2):458-65;
22. Daeock Choi, "Synthesis, Chemistry, and Biological Evaluation of Medicinally Relevant Compounds", *A Bell & Howell Company*, December, 1995, pp.1-208;
23. Abstract of International Application No. WO99/02146, dated January 21, 1999; and
24. South Africa Patent Application No. 98/5940, issued to Takuya Seko, et al., dated July 6, 1998.

Copies of the art cited herein is also being submitted herewith.

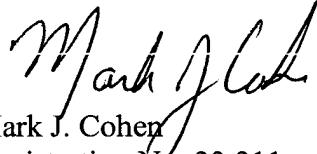
References 1-6 were cited in an International Search Report received from the European Patent Office dated September 26, 2002. Applicant is submitting copies of the above-cited references, together with a copy of the Search Report.

The relevance of references 7-11 has been described in the specification.

Although art is listed hereinabove and in the accompanying PTO-1449 form, such listing should not be construed as an admission by applicant that all of the art listed is prior art.

Inasmuch as this Information Disclosure Statement is being submitted in accordance with the schedule set out in 37 C.F.R. §1.97(b), no petition, certification or fee is required.

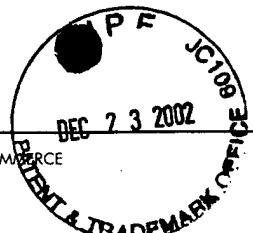
Respectfully submitted,



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MJC:gmj/sf
Enclosures PTO Form 1449
Twenty-four (24) references



Form PTO-1449 U.S. DEPARTMENT OF COMMERCE
(REV. 7-80) PATENT AND TRADEMARK OFFICE

LIST OF PRIOR ART CITED BY APPLICANT

(Use several sheets if necessary)

Atty. Docket No.
13095

Serial No.
09/938,677

Applicant
Robert H. Harris

Filing Date
August 24, 2002

Group
Unassigned

U.S. PATENT DOCUMENTS

EXAMINER INITIAL*		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE (if appropriate)
	AA	5,378,729	1/3/1995	Kohn et al.			RECEIVED
	AB	5,885,999	3/23/1999	Elliot et al.			DEC 27 2002
		6,133,261	10/17/2000	Harris			TECH CENTER 1600/2000
		6,228,875 B1	5/8/2001	Tsai et al.			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
		WO 99/43309	9/2/1999	PCT				
		EPO 997147 A1	7/3/1998	EPO				
		EP1 084 704 A1	3/21/2001	EPO				
		WO 99/03460	1/28/1999	PCT				
		98/5940	7/6/1998	South Africa				

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	Kohn H. et al., "Synthesis and anticonvulsant activities of α -heterocyclic α -acetamido-N-benzylacetamide derivatives", <i>Journal of Medicinal Chemistry</i> , United States 29 October 1993, vol. 36, no. 22, pp. 3350-3360, ISSN: 0022-2623, page 3355, column 1, paragraph 2, example 3F; table 1;
	Shridhar V. Andurkar, et al., "The Anticonvulsant Activities of N-Benzyl 3-Methoxypropionamides", <i>Bioorganic & Medicinal Chemistry</i> 7 (1999), pp. 2381-2389, pg. 2381, column 2; example 3, pg. 2385, column 1, paragraph 2-paragraph 3, XP001097157;
	Claudio Toniolo, et al., "A crystal-state, solution and theoretical study of the preferred conformation of linear C. α - α -diphenylglycine derivatives and dipeptides with potential anticonvulsant activity", <i>Int. J. Pept. Protein Res.</i> 44. 1994, 85-95, XP001074241, , Page 85, column 1, paragraph 2, Page 86, column 1; example XIV;
	Claudio Toniolo, et al., "A crystal-state, solution and theoretical study of the preferred conformation of linear C. α - α -diphenylglycine derivatives and dipeptides with potential anticonvulsant activity", <i>Int. J. Pept. Protein Res.</i> 44. 1994, 85-95, XP001074241, , Page 85, column 1, paragraph 2, Page 86, column 1; example XIV;
	Solomon H. Snyder, et al., "D-Amino Acids as Putative Neurotransmitters: Focus on D-Serine, <i>Neurochemical Research</i> , Vol. 25, No. 5, 2000, pp. 553-560;
	Abstract of International Application No. WO 99/02146 dated January 21, 1999

O I P E S C I E

DEC 23 2002

P A T E N T & T R A D E M A R K

	David E. Baranano, et al., "Atypical neural messengers", <i>Trends in Neurosciences</i> , vol. 24, No. 2, February 2001, pp. 99-106;
	J.M. Elliott, et al., "Serine Derived NK ₁ Antagonists 1: The Effect of Modifications to the Serine Substituents", <i>Bioorganic & Medical Chemistry Letters</i> 8 (1998) pp.1845-1850;
	Solomon H. Snyder, M.D., et al., "Novel Neurotransmitters and their Neuropsychiatric Relevance", <i>Am J Psychiatry</i> , 157:11, November 2000, pp. 1738-1751;
	Robert Berkow, M.D., et al., "The Merck Manual of Diagnosis and Therapy", <i>Merck Research Laboratories</i> , (1992), pp. 1406-1615;
	Harris FRC, and Schwarz Pharma AG, <i>Windover Information Inc.</i> , 2000, page 122;
	Herman Wolosker, et al., "Serine racemase: A glial enzyme synthesizing D-serine to regulate glutamate-N-methyl-D-aspartate neurotransmission", <i>PNAS</i> , vol. 96, no. 23, November 9, 1999, pp. 13409-13414;
	Fu Y, et al., "Systemic nicotine stimulates dopamine release in nucleus accumbens: Reevaluation of the role of N-methyl-D-aspartate receptors in the ventral tegmental area [In Process Citation]", <i>J Pharmacol Exp Ther</i> 2000, Aug;294(2):458-65; and
	Daeock Choi, "Synthesis, Chemistry, and Biological Evaluation of Medicinally Relevant Compounds", <i>A Bell & Howell Company</i> , December, 1995, pp.1-208.
EXAMINER	DATE CONSIDERED

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.